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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,288	03/21/2001	Noriko Ito	14419	4794
23389	7590	04/06/2006	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/814,288

Applicant(s)

ITO, NORIKO

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3622

1. Claims 1-17 have been examined. Application 09/814,288 (ADVERTISEMENT PROVIDING SYSTEM AND METHOD) has a filing date 03/21/2001 and foreign priority of 03/30/00.

***Response to Amendment***

2. In response to Non Final Rejection filed 10/04/2005, the Applicant filed a Request for reconsideration on 01/09/2006.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (U.S. 6,571,279) in view of Hall et al (US 6,026,375).

As per claims 1, 9 and 17, Herz teaches:

An advertisement providing system comprising a communication line, one or more communication dealer terminals, one or more consumer terminals and one or more company terminals, these terminals being interconnected by the communication line, wherein:

each communication dealer terminal includes a means for storing advertisement data and also consumer's position data and taste data, a means for selecting

Art Unit: 3622

advertisement data for each consumer by taking the consumer's position data and taste data, and a current time into considerations (see Herz column 25, line 10 – column 26, line 62; column 11, lines 52-55; “time of day”). Herz does not expressly teach and a means for calculating a schedule time of consumer's arrival at a shop from a present position of the consumer and for transmitting the schedule time to a company terminal. However, Hall teaches “a method of processing an order from a mobile customer comprises receiving an order from a mobile customer, wherein the order includes customer identifying information; receiving customer location information from a location determination system; identifying at least one facility capable of completing the order; determining an estimated time of arrival of the customer at each identified facility using the customer location information; determining an amount of time needed by each identified facility to complete the order; and determining which facility of the at least one identified facility is capable of completing the order prior to the customer's estimated time of arrival at the determined facility” (see column 2, lines 49-61). Herz discloses in column 26, lines 49-60 “Once relevant products are identified, a user en route to a destination near a vendor's store can pre-order their groceries or other merchandise directly so that the user could simply pick up their pre-packaged grocery order at the time of arrival at the store. For example, an advertisement for a product on an electronic billboard could easily be pre-ordered from the user's automobile or device”. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that once a customer is en route to a destination near a vendor's store identifies relevant products, said customer would preorder their order and

Art Unit: 3622

the Herz system would determine the estimated time of arrival of said customer to said vendor's store based upon said customer's location, as taught by Hall . This schedule time information would be used by said store to reduce waiting time of said customer upon arrival at said store.

each consumer terminal includes a means for displaying advertisement data received from a communication dealer terminal, a means for transmitting the consumer terminal's position data to the communication dealer terminal, and a means for transmitting reservation request data for a product or a service selected by the consumer on the basis of the advertisement data received (see Herz column 26, lines 49-62); and

each company terminal includes a means for producing advertisement data and transmitting the produced advertisement data to the communication dealer terminal (see Herz column 16, lines 7-34),

a means for receiving the reservation request data via the communication dealer terminal and executing a reservation process, a means for checking, when the consumer comes to a shop, whether the consumer has requested a reservation and outputting a result of the checking (see Herz column 26, lines 29-62)

wherein the communication dealer terminal further includes means for calculating an advertisement effect based on the transmitted reservation request data of the consumer (see Herz column 16, lines 22-25; column 18, lines 1-6; column 25, lines 5-15).

As per claims 2 and 10, Herz teaches:

Art Unit: 3622

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the advertisement data as electronic mail to the consumer terminal (see column 8, lines 51-65).

As per claims 3 and 11, Herz teaches:

The advertisement providing system according to claim 1, wherein the consumer terminal transmits the reservation request data as electronic mail to the communication dealer terminal (see column 25, lines 25-67).

As per claims 4 and 12, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the reservation request data as electronic mail to the company terminal (see column 26, lines 29-62).

As per claims 5 and 13, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication line is an Internet system (see column 25, lines 55-67).

As per claims 6 and 14, Herz teaches:

The advertisement providing system according to claim 1, but does not expressly teach wherein the means for calculating the scheduled time of the consumer's arrival calculates the schedule time based on the present position of the consumer, the position of the shop as described in the advertisement and the present time. However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 6.

Art Unit: 3622

4. Claims 7, 8, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (U.S. 6,571,279) in view of Hall et al (US 6,026,375) and further in view of Angles (US 5,933,811).

As per claims 7 and 15, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal further includes a means for calculating advertisement effect from transmitted reservation request data of consumers (see Herz column 25, lines 1-25) but fails to teach and from the contract of advertisement requested to it. However, Angles teaches a system that monitors the actual delivery of advertisements to consumers and bill advertisers based upon said actual delivery (see Angles column 16, lines 6-15). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the Application was made, to know that Herz's would monitor the responses of users to advertisements, such as the number of users which click through said advertisements and/or purchase products related to said advertisements (see Herz column 18, lines 1-6) and would use said monitoring to bill advertisers, as taught by Angles. Herz would be motivated to bill advertisers based upon the actual delivery of advertisements to consumers (i.e. purchase products related to said advertisement) in order to guarantee said advertisers that their ads would reach their intended target.

As per claims 8 and 16, Herz teaches:

The advertisement providing system according to claim 7, but fails to teach wherein the communication dealer terminal further includes a means for determining

Art Unit: 3622

advertisement fee from the advertisement effect. However, the same argument made in claim 7 is also made in claims 8 and 16.

### **Response to Arguments**

5. Applicant's arguments filed 01/09/2006 have been fully considered but they are not persuasive. The Applicant argues that the Examiner stated that claims 1-17 are rejected over Herz in view of Hall but in the body of the rejection, it appears that claims 1-6, 9-14 and 17 are rejected over combination of Herz and Hall and that claims 7, 8 and 15 are rejected over the above combination in view of Angles. The Examiner answers that it was a typographical error for such combination and the Examiner fixed said error in this Office Action.

The Applicant argues that Hall is directed to only placing orders from a mobile phone and there is no teaching or suggestion of orders being placed in response to advertising received on the phone. The Examiner answers that Herz teaches receiving advertising on phone where the display algorithm determine what is displayed on the display device 107 where the display device 107 can be in fact a component of the user terminal device U1-U3 (see Herz column 6, line 60 – column 7, line 7) and where the user terminal device U1-U3 includes a cellular phone, PCAS telephone (see Herz column 7, line 67 – column 8, line 5). Herz teaches that once relevant products are identified, the user on route to a destination near a vendor's store can pre-order their groceries or other merchandise directly, for an example, an advertisement for a product on an electronic billboard could easily be pre-ordered from the user's device (see Herz

Art Unit: 3622

column 26, lines 30-57). Therefore, contrary to Applicant's argument, in Herz there is suggestion of orders being placed in response to advertising received on the phone.

The Applicant argues that Herz is not directed to a system for providing advertisement to individual users. The Examiner answers that Herz teaches that the beacon capability of the mobile subscriber can be used to identify a user, and using this subscriber identification information, to locate and fetch a user profile for the identified subscriber (see Herz column 4, lines 25-35) and that a user profile is associated with a particular user such as name, user address, etc (see Herz column 6, lines 17-20). In Herz the user profile can be used as part of the information customization architecture (see Herz column 4, lines 35-50). Therefore, Herz teaches targeting advertisement to particular users.

The Applicant argues that Herz teaches away from direct advertising and ordering from consumers because the user's true identity and individual preferences are specifically not known to the service provider. The Examiner answers that Herz teaches in column 8, lines 42-50 that that some but not all of user specific information in their user profile remains confidential and to be disclosed only under certain circumstances and user's personal wishes. Also, Herz teaches in column 16, lines 15-20 that advertiser may be willing to provide products of a particular type, quality and price if the user is willing to reveal certain specified attributes. Therefore, contrary to Applicant's argument, in Herz the user's identity is no completely unknown to the service provider (i.e. advertiser).

Art Unit: 3622

The Applicant argues that Herz does not take into consideration the current time when deciding what advertising to provide. The Examiner answers that Herz teaches that advertisers can use any information available, such as time of day to determine the bid to target advertisements (see Herz column 11, lines 52-55). Therefore, Herz takes into consideration the current time.

### **Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

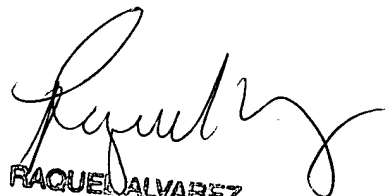
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra  
March 25, 2006



RAQUEL ALVAREZ  
PRIMARY EXAMINER